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EXAMINER				
STULTZ, JESSICA T				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@ORTPATENT.COM

### Office Action Summary

**Application No.**

10/594,937

**Applicant(s)**

BEGON ET AL.

**Examiner**

JESSICA T. STULTZ

**Art Unit**

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-10,14,15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-10,14,15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Examiner's Comments***

For applicant's information, the amendments to claims 1, 5, and 7 overcome the previous objections to claims 5 and 7. Additionally, the amendments to independent claim 1 overcome the previous obviousness type double patenting rejection of claims 1-2, 5-6, 16-17, and 20 over Giraudet '574.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, and 7-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13, 15, and 17-18 of copending Application No. 12/067,854 (cited herein as US 2008/0252846), herein referred to as Biver '846. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3, and 7-10 of the instant application are anticipated or made obvious by claims 13, 15, and 17-18 of Biver '846.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding claim 1, Biver '846 discloses a transparent and polarizing vision element divided into several zones, at least two of said zones being associated with a light polarizing filter, the light traversing the element being affected differently for two of said zones according to a direction of polarization of said light (claims 13/15), the element being an ophthalmic lens and comprising: a first zone associated with a polarizing filter oriented vertically with respect to a use position of the element, said first zone being located in a lateral part of the element with respect to the use position (claims 13/15/17); a second zone associated with a polarizing filter oriented horizontally, the element being characterized in that the second zone is located in the upper part of the element with respect to the use position (claims 13/15/17); and a third zone that

is not-polarizing and is located in the lower part of the element with respect to the use position (claims 17-18), but does not specifically disclose that the ophthalmic lens is a spectacle lens. However, it is well known in the art of ophthalmic lenses for the lenses to be spectacle lenses. Therefore it would have been obvious for the lens to be spectacle lenses for the purpose of providing removable vision correction to the patient.

Regarding claim 3, Biver '846 discloses the limitations therein (claims 13/15).

Regarding claim 7, Biver '846 discloses the limitations therein (claims 15, 17-18).

Regarding claims 8-10, Biver '846 discloses a polarizing vision element as shown above, but does not specifically disclose the dimensions of the lens or that the first and second zones are separated by a distance lying between 10 and 60 mm, specifically between 10 and 40 mm, more specifically between 20 and 40 mm, in a central portion of said element. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the device of Biver '846 to satisfy the claimed dimensions for the purpose of providing more than two polarization zones on the lens, since it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In re Gardner v. Tec Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spahl DE 10237684, herein referred to as Spahl '684.

Regarding claim 1, Spahl '684 discloses a transparent and polarizing vision element (visor 1) divided into several zones (Abstract, Figure 3), at least two of said zones being associated with a light polarizing filter, the light traversing the element being affected differently for two of said zones according to a direction of polarization of said light (Paragraphs 20-24), the element being a motorcycle visor (Abstract) and comprising: a first zone associated with a polarizing filter oriented vertically with respect to a use position of the element (Paragraphs 20-24, wherein the upper portion of the visor comprises both a horizontal polarization area as claimed), said first zone being located in a lateral part of the element with respect to the use position (Figure 3); a second zone associated with a polarizing filter oriented horizontally (Paragraphs 20-24, wherein the upper portion of the visor comprises both a horizontal polarization area as claimed), the element being characterized in that the second zone is located in the upper part of the element with respect to the use position; and a third zone (2) that is not-polarizing and is located in the lower part of the element with respect to the use position (Figure 3, Paragraphs 22-24), but does not specifically disclose that the element is a spectacle lens. However, it is well known in the art of lenses used for ophthalmic purposes, such as a motorcycle visor (Abstract) for the lenses to be spectacle lenses. Therefore it would have been obvious for the lens to be spectacle lenses for the purpose of providing removable vision correction to the patient.

Regarding claim 3, Spahl '684 further discloses that the first zone associated with the vertically oriented polarization filter is adjacent to a lateral edge of the element (Figure 3).

Regarding claim 17, Spahl '684 further a polarizing vision element as shown above, but does not specifically discloses that the element is a spectacle lens used in a pair of spectacles. However, it is well known in the art of lenses used for ophthalmic purposes, such as a motorcycle visor (Abstract) for the lenses to be spectacle lenses. Therefore it would have been obvious for the lens to be spectacle lenses for the purpose of providing removable vision correction to the patient.

Claims 5-6 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spahl '684, as applied to independent claim 1 above, in view of Fiala US 5,142,411, herein referred to as Fiala '411.

Regarding claims 5-6, Spahl '684 discloses a polarizing vision element as shown above, but does not specifically disclose that a first zone associated with a vertically oriented polarization filter extends over a width going from the outer lateral edge of said element to a distance lying between 5 and 75 mm, specifically, between 5 and 30 mm, measured on a straight line going from said outer lateral edge toward the optical center as defined previously of said element. In the same field of endeavor of polarizing spectacle lenses (Abstract), Fiala '411 teaches of providing a lens having at least one horizontally oriented polarization (reading portion 40, Figure 9A) and vertically oriented polarization (distance portion 50, Figure 9A) (Column 21, lines 33-66 and Column 22, lines 30-55), wherein the first (distance, vertically oriented) zone (50) associated with a vertically oriented polarization filter extends over a width going from the outer lateral edge of said element to a distance lying between 5 and 75 mm, specifically, between

5 and 30 mm, measured on a straight line going from said outer lateral edge toward the optical center as defined previously of said element (Column 15, lines 24-36, wherein the radius of the lens ranges between 7.85 to 7.8 mm and portion 50 covers the entire lens and thereby fulfills the claim requirements, Figure 9A). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of Fiala '411 with the polarizing vision element of Spahl '684 for the purpose of providing cosmetically pleasing glasses that reduce the effects of polarized light (Column 21, line 33-Column 22, line 55).

Regarding claims 14-15, Spahl '684 and Fiala '411 disclose and teach of a polarizing vision element as shown above, but do not specifically disclose that the limit, between the zone associated with a horizontally oriented polarization filter and the zone associated with no polarization filter, passes between the optical center of said element and a point situated 20 mm beneath said optical center, more specifically, between the optical center and a point situated 10 mm beneath said optical center. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the device of Spahl '684 and Fiala '411 to satisfy the claimed dimensions for the purpose of providing multiple polarization zones on a lens, since it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In re Gardner v. Tec Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).



Claims 1, 3, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimberger US 3,211,047, herein referred to as Heimberger '047, in view of Serrell US 2,334,446, herein referred to as Serrell '446.

Regarding claim 1, Heimberger '047 discloses a transparent and polarizing vision element divided into several zones, at least two of said zones being associated with a light polarizing filter (fields A-D, Column 3, lines 52-68, Figures 1 and 3), the light traversing the element being affected differently for two of said zones according to a direction of polarization of said light (Column 4, lines 28-52, where fields A-D affect light differently), the element being a spectacle lens (Column 4, lines 7-68, wherein the spectacles are shown in Figures 1 and 3) and comprising: a first zone associated with a polarizing filter oriented vertically with respect to a use position of the element, said first zone being located in a lateral part of the element with respect to the use position (Column 4, lines 28-52, where field D is oriented vertically and located in a lateral portion of the vision element, Figures 1 and 3); a second zone associated with a polarizing filter oriented horizontally, the element being characterized in that the second zone is located in the upper part of the element with respect to the use position (Column 4, lines 28-52, where fields B and C are oriented horizontally and located in an upper portion of the vision element, Figures 1 and 3), but does not specifically disclose a third zone that is not-polarizing and is located in the lower part of the element with respect to the use position. In the same field of endeavor of polarizing spectacle lenses (Title, Column 1, lines 54-55), Serrell '446 teaches of providing a lens having three different zones (10, 16, 22) with different polarization orientations (Column 1, line 55-Column 2, line 30, Figure 1), specifically wherein one of the zone is not-polarizing and is located in the lower part of the element with respect to the use position

(Column 1, line 55-Column 2, line 30, wherein segment 22 is unpolarized). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of Serrell '446 with the polarizing vision element of Heimberger '047 for the purpose of reducing road glare on a driver's eyes without moving their head (Column 1, lines 11-17 and Column 2, line 47-Column 3, line 3).

Regarding claim 3, Heimberger '047 and Serrell '446 disclose and teach of a polarizing vision element as shown above, and Heimberger '047 further discloses that the first zone associated with the vertically oriented polarization filter is adjacent to a lateral edge of the element (Shown in Figure 1, wherein field D is vertically oriented and adjacent to a lateral edge of the vision element).

Regarding claim 17, Heimberger '047 and Serrell '446 disclose and teach of a polarizing vision element as shown above, and Heimberger '047 further discloses a pair of spectacles, wherein said transparent vision element constituting one lens of said pair of spectacles (Column 4, lines 7-68, wherein the spectacles are shown in Figures 1 and 3).

Claims 5-6 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimberger '047 in view of Serrell '446, as applied to independent claim 1 above, and further in view of Fiala US 5,142,411, herein referred to as Fiala '411.

Regarding claims 5-6, Heimberger '047 and Serrell '446 discloses a polarizing vision element as shown above, but does not specifically disclose that a first zone associated with a vertically oriented polarization filter extends over a width going from the outer lateral edge of said element to a distance lying between 5 and 75 mm, specifically, between 5 and 30 mm, measured on a straight line going from said outer lateral edge toward the optical center as

defined previously of said element. In the same field of endeavor of polarizing spectacle lenses (Abstract), Fiala '411 teaches of providing a lens having at least one horizontally oriented polarization (reading portion 40, Figure 9A) and vertically oriented polarization (distance portion 50, Figure 9A) (Column 21, lines 33-66 and Column 22, lines 30-55), wherein the first (distance, vertically oriented) zone (50) associated with a vertically oriented polarization filter extends over a width going from the outer lateral edge of said element to a distance lying between 5 and 75 mm, specifically, between 5 and 30 mm, measured on a straight line going from said outer lateral edge toward the optical center as defined previously of said element (Column 15, lines 24-36, wherein the radius of the lens ranges between 7.85 to 7.8 mm and portion 50 covers the entire lens and thereby fulfills the claim requirements, Figure 9A). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of Fiala '411 with the polarizing vision element of Heimberger '047 and Serrell' 446 for the purpose of providing cosmetically pleasing glasses that reduce the effects of polarized light (Column 21, line 33-Column 22, line 55).

Regarding claims 14-15, Heimberger '047, Serrell' 446 and Fiala '411 disclose and teach of a polarizing vision element as shown above, but do not specifically disclose that the limit, between the zone associated with a horizontally oriented polarization filter and the zone associated with no polarization filter, passes between the optical center of said element and a point situated 20 mm beneath said optical center, more specifically, between the optical center and a point situated 10 mm beneath said optical center. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the device of Heimberger '047, Serrell' 446 and Fiala '411 to satisfy the claimed dimensions for the purpose

of providing multiple polarization zones on a lens, since it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In re Gardner v. Tec Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

### ***Response to Arguments***

Applicant's arguments filed February 12, 2009 with respect to the double patenting rejection over Biver '846 have been fully considered but they are not persuasive. Specifically, applicant argues that the scope of the present invention is much larger than that of Biver '846, however, the examiner disagrees since claims 13, 15, 17-18 of Biver '846 make obvious claim 1 as shown above.

Applicant's arguments with respect to claims 1 3, 5-6, 14-15, and 17 have been considered but are moot in view of the new ground(s) of rejection as shown above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA T. STULTZ whose telephone number is (571)272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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